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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/600,281

06/20/2003

Peter Strarup Jensen

SUNMP155

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06/26/2008

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EXAMINER

NGUYEN, DUSTIN

ART UNIT

PAPER NUMBER

2154

MAIL DATE

DELIVERY MODE

06/26/2008

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 10/600,281	Applicant(s) JENSEN ET AL.	
	Examiner DUSTIN NGUYEN	Art Unit 2154	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 25 January 2008.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-20 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-20 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

1. Claims 1 – 20 are presented for examination.

Claim Rejections - 35 USC § 112

2. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

The analysis under 35 U.S.C. 112, first paragraph, requires that the scope of protection sought be supported by the specification disclosure. The pertinent inquiries include determining (1) whether the subject matter defined in the claims is described in the specification and (2) whether the specification disclosure as a whole is to enable one skilled in the art to make and use the claimed invention.

(1) Claims 1, 9 and 17 are rejected under 35 U.S.C. 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

The "invention" for the purpose of the first paragraph analysis is defined by the claims. The description requirement is simply that the claimed subject matter must be described in the specification. The function of the description requirement is to ensure that the applicant had

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possession of the invention on the filing date of the application. The application need not describe the claim limitations exactly, but must be sufficiently clear for one of ordinary skill in the art to recognize that the applicant's invention encompasses the recited limitations. The description requirement is not met if the application does not expressly or inherently disclose the claimed invention.

Specification does not explicitly describe nor is sufficiently clear for one of ordinary skill in art to recognize the following steps as recited in claims 1, 9 and 17:

- wherein the discovery transaction, the subscription transactions and the delivery transactions may be requested by another client device different from the client device.

At best, Applicants disclose that it should be noted that the object id returned in the discovery reply can be different from the object id sent in the request, since the session id can be utilized to identify which request the reply corresponds to, the object ids do not need to match, hence, different object ids can be used to indicate a redirection has occurred on the server for the previous reply, page 17, lines 18-23. It is unclear how this quoted paragraph of the present specification can be equated with the applicant's interpretation that "the client device has the ability to receive the transactions based on a request made by another client device as the reply received (based on a request by another client device) uses session id to identify the request to which the reply corresponds", Remarks page 9, and thus it is unclear how this quoted paragraph of the present specification can be equated with the claimed limitations "wherein the discovery transaction, the subscription transactions and the delivery transactions may be requested by another client device different from the client device" in claims 1, 9 and 17.

Therefore, claims 1, 9 and 17 are unclear that the one ordinarily skilled in the art cannot recognize the encompassed claimed limitations.

(2) Claims 1, 9 and 17 are rejected under 35 U.S.C. 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention. The enablement requirement necessitates a determination that the disclosure contains sufficient teaching regarding the subject matter claimed as to enable one skilled in the pertinent art to make and use the claimed invention. In essence, the scope of enablement provided to one ordinarily skilled in the art by the disclosure must be commensurate with the scope of protection sought by the claims.

Currently, the most prevalent standard for measuring sufficient enablement to meet the requirements of 112 is that of "undue experimentation". The test is whether, at the time of the invention, there was sufficient working procedure for one skilled in the art to practice the claimed invention without undue experimentation. It is important to note that the test of enablement is not whether any experimentation is necessary, but whether, if experimentation is necessary, it is undue. A skilled artisan is given sufficient direction or guidance in the disclosure. Moreover, the experimentation required, in addition to not being undue, must not require ingenuity beyond that expect of one of ordinary skill in the art.

Undue experimentation and ingenuity would be required beyond one ordinarily skilled in the art to practice the following steps as recited in claims 1, 9 and 17:

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- wherein the discovery transaction, the subscription transactions and the delivery transactions may be requested by another client device different from the client device

Undue experimentation would be needed to make the discovery transaction, the subscription transactions and the delivery transactions may be requested by another client device different from the client device.

Claim Rejections - 35 USC § 112

3. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

4. Claims 1-20 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

- A. The claim language in the following claims is being considered as indefinite:

- I. As per claims 1, 9 and 17, the term “may be” in the claimed limitation of “wherein the discovery transactions, the subscription transactions and the delivery transactions may be requested by another client device different from the client device” is being considered as indefinite since the transactions may happen or may not happen.

Claim Rejections - 35 USC § 103

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5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

6. Claims 1-20 are rejected under 35 U.S.C. 103(a) as being unpatentable over Mehta et al. [US Patent Application No 2002/0131404], in view of Kolbe et al. [US Patent No 6,341,316].

7. As per claim 1, Mehta discloses the invention as claimed including a computer readable medium in which a provisioning application is stored, the provisioning application including program instructions which when read by a computer system, cause the computer system to perform a method for provisioning services between a client and a provisioning server [i.e. methods and systems for maintaining and provisioning wireless applications] [Figure 1; Abstract; paragraphs 0005 and 0012], comprising the operations of:

providing discovery transactions that allow the client device to retrieve information regarding services available to the client device from a provisioning server [i.e. the MAS to retrieve a list of available applications that can be downloaded to the subscriber's device, this is referred to application discovery] [Figure 4; and paragraphs 0006, 0067 and 0070], wherein a service comprises a plurality of content files capable of being installed on the client device [i.e. installation or uninstallation of applications on the wireless device] [paragraphs 0063 and 0064], wherein the client device is configured to restrict granularity of services requested from the provisioning server [i.e. the list of applications that the subscriber desires to have during

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application discovery] [paragraphs 0116, 0117, 0119 and 0120], the granularity defined by selection of one or more properties of provisioning services the client device requests to discover [i.e. application discovery returns a list of content that can be downloaded that match criteria that are designated by the subscriber] [Figure 20; and paragraphs 0006 and 0141];

affording subscription transactions that allow the client device to manage content in service directories [i.e. a Personalization Website, which is used by subscribers to order, ... and to manage applications] [paragraphs 0091, 0115 and 0116], wherein a service directory comprises a plurality of services [paragraphs 0091, 0131]; and

wherein the discovery transaction, the subscription transactions and the delivery transactions may be requested by another device different from the client device [i.e. the Administrator provides a Content Provider Website for content providers to submit downloadable applications to be downloaded to target devices] [Figures 9A-9C; and paragraphs 0097 and 0098].

Mehta does not specifically disclose

providing delivery transactions that allow the client device to download data related to services based on synchronization of the client device with the provisioning server, wherein the synchronization ensures that view of delivered services on the client is in synchronization with the view of the delivered services on the provisioning server.

Kloba discloses

providing delivery transactions that allow the client device to download data related to services based on synchronization of the client device with the provisioning server [i.e. the web synchronization module controls synchronization of web content to client] [Figures 11I and

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112; col 9, lines 1-14; and col 14, lines 46-53], wherein the synchronization ensures that view of delivered services on the client is in synchronization with the view of the delivered services on the provisioning server [i.e. data on the client and server are the same] [col 5, lines 29-40; and col 19, lines 33-col 20, lines 3].

It would have been obvious to a person skill in the art at the time the invention was made to combine the teaching of Mehta and Kloba because the teaching of Kloba on synchronization would enable applications available via a network or via an Internet/intranet to download and to run on mobile devices and manage the variables relevant to a mobile device/server environment [Kloba, col 4, lines 45-52].

8. As per claim 2, Mehta discloses wherein the discovery transactions includes a service discovery transaction that allows the client device to obtain information regarding a particular service [i.e. application discovery returns a list of content that can be downloaded that match criteria] [Figure 4; and paragraphs 0006 and 0067].

9. As per claim 3, Mehta discloses wherein the discovery transactions include a service directory discovery transaction that allows the client device to obtain information regarding a particular service directory [i.e. A subscriber's Personal Access List is the list of applications that the subscriber desires to have the MAS display during application discovery] [paragraphs 0016, 0019 and 0020].

10. As per claim 4, Mehta discloses wherein the subscription transactions include a service subscription transaction that allows a service to be added to a service directory [i.e. adding applications] [Figures 11E-H; paragraphs 0116 and 0117].

11. As per claim 5, Mehta discloses wherein the subscription transactions include an unsubscribe transaction that allows a service to be removed from a service directory [i.e. removing applications] [Figure 11J; and paragraphs 0116 and 0118].

12. As per claim 6, Mehta discloses wherein the delivery transactions include an update transaction that allows that allows the client device to obtain a provisioning update comprising a list of services that should be installed on the client device [i.e. a list of new applications that can be potentially downloaded] [paragraph 0063].

13. As per claim 7, Mehta discloses wherein the delivery transactions include a notification transaction that allows the provisioning server to request the client device to perform an update transaction [i.e. a notification that an updated version is available] [paragraphs 0063 and 0110].

14. As per claim 8, Mehta discloses wherein the delivery transactions include a delivery transaction that allows the client device to download data related to a service [i.e. send the packaged application to the requesting subscriber device] [310, Figure 3; and paragraphs 0070 and 0131].

15. As per claims 9-16, they are method claimed of claims 1-8, they are rejected for similar reasons as stated above in claims 1-8.

16. As per claims 17-20, they are apparatus claimed of claims 1-8, they are rejected for similar reasons as stated above in claims 1-8.

17. THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Dustin Nguyen whose telephone number is (571) 272-3971. The examiner can normally be reached on flex.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Nathan Flynn can be reached at (571) 272-1915. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

/Dustin Nguyen/
Primary Examiner, Art Unit 2154